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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,761	01/26/2004	Michael Alan Siecke	44150/182	8779

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EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/764,761	Applicant(s) SIECKE, MICHAEL ALAN	
	Examiner Luan K. Bui	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-21, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases “being adapted” in claims 1, 11 and 24 and “being configured and dimensioned” in claim 11 render the claim indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention and also the claimed invention is directed to a blank not the package as disclosed after the phrases “being adapted” and “being configured and dimensioned”. For the purpose of this Office Action, the limitations following the phrases “being adapted” and “being configured and dimensioned” are not part of the claimed invention because the claimed invention is directed to the blank only. The phrases “said horizontal midline” in claims 5 and 6 and “said exposed first face” and “said halves” in claim 7 lack proper antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Weber (2,634,046). Weber discloses a blank comprising an unfolded sheet of cardboard/paperboard

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material defining a first face and a second face opposite the first face, the first face being flat, coated (a) and printed (column 1, line 11) and the second face being unprinted and defining at least one pair of adjacent parallel grooves (3, 5). As to claim 25, Weber discloses a package comprising a paper board component (4, 7) having a concealed inner face defining at least one groove (5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (2,634,046) in view of Kuchenbecker (4,740,163). Weber discloses the blank as above having all the limitations of the claims except for the grooves being formed by laser. Kuchenbecker teaches a paperboard blank for forming a package comprising channels/grooves (25, 26) formed by laser. It would have been obvious to one having ordinary skill in the art in view of Kuchenbecker to modify the blank of Weber so the grooves are formed by laser for better removing the material from the blank and because the selection of the specific method for forming the grooves such as the method as claimed would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well. As to claim 2, Weber discloses the grooves extend into the sheet to a depth of at least one-half of the thickness of the

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sheet (Figure 2). As to claim 7, the exposed first face of the blank of Weber is capable to receive thereon at least one plastic component adapted to receive a recording medium.

7. Claims 4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (2,634,046) in view of Voss (5,427,309). Weber discloses the blank as above having all the limitations of the claims except for the second face being defined at least two spaced apart pairs of parallel grooves. Voss shows a blank (10) having at least two spaced apart pairs of parallel grooves (37-42) (Figure 8). It would have been obvious to one having ordinary skill in the art in view of Voss to modify the blank of Weber so the second face comprises at least two spaced apart pairs of parallel grooves to facilitate folding.

8. Claims 5, 6, 12, 13, 15-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber (2,634,046) in view of Matsuoka (6,761,307) or Rammer (1,973,930). Weber discloses the blank as above having all the limitations of the claims. Weber further discloses a package formed from the blank comprising a paperboard component (4, 7) having a concealed inner face defining at least one groove (5). However, Weber fails to show the blank being folded along a horizontal midline and at least one pair of adjacent parallel grooves. Matsuoka teaches a box/package comprising a component (4b, 9a, Figures 1 and 3) formed of a blank folded along a horizontal midline (81) to form a pair of grooves (8, Figure 3). Rammer shows a carton comprising a fiberboard component (9, 10, Figure 3) formed of a blank folded along a horizontal midline (8). It would have been obvious to one having ordinary skill in the art in view of Matsuoka or Rammer to modify the package of Weber so the paperboard component

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is formed along a horizontal midline as taught by Matsuoka or Rammer to form at least one pair of adjacent parallel grooves as taught by Matsuoka to reduce interference due to bending of the component.

As to claim 13, Weber discloses the grooves extend into the sheet to a depth of at least one-half of the thickness of the sheet (Figure 2).

As to claims 15 and 19-21, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the package of Weber as modified so the second face includes a second and a third spaced apart pairs of adjacent parallel grooves since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 12 above, and further in view of Kuchenbecker (4,740,163). Weber further fails to show the grooves being formed by laser. Kuchenbecker teaches a paperboard blank for forming a package comprising channels/grooves (25, 26) formed by laser. It would have been obvious to one having ordinary skill in the art in view of Kuchenbecker to modify the package of Weber so the grooves are formed by laser for better removing the material from the blank and because the selection of the specific method for forming the grooves such as the method as claimed would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well.

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Allowable Subject Matter

10. Claims 22 and 23 are allowed.

11. Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb
April 28, 2006



Luan K. Bui
Primary Examiner
Art Unit 3728